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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,522	11/27/2000	Philip M. Parker	032031.0002.UTL	4892

20985 7590 03/11/2004

FISH & RICHARDSON, PC  
12390 EL CAMINO REAL  
SAN DIEGO, CA 92130-2081

EXAMINER
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NGUYEN, DANG T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 03/11/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/723,522

Applicant(s)

PARKER, PHILIP M.

Examiner

Dang T Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2-3.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to communications: Application filed on 11/27/2000.
2. Claims 1 – 31 are pending in this case. Claims 1, 16, and 29 are independent claims.
3. IDS filed on 11/27/2000.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-2, 5-10, 14-19, 22-27, and 29-30 are rejected under 35**

**U.S.C. 102(b) as being anticipated by Maegawa, U.S. patent No. 5,966,386 –  
filed Oct. 12, 1999.**

**Regarding independent claims 1 and 16,** Figure 1 of Maegawa discloses a computer-based method and system of authoring title material (Figs. 18 – 20), comprising the steps of: providing an automation program, macro or module (Fig. 1 information servers [32], Col. 8 lines 44-46); and automatically authoring, using a computer, a title material derived from at least one database file using said automation program, macro, or module (Figs. 18-20 [32a]).

**Regarding dependent claims 2 and 17**, Maegawa further discloses comprising: automatically distributing said title material (Fig. 20 [32a]) to a second computer over a system of networked computers (Fig. 1).

**Regarding dependent claims 5 and 22**, Maegawa further discloses comprising: automatically authoring meta material (Col. 19 line 41 "content data" , Fig. 18 [72, 82]) relating to said title material (Col. 19 line 42 "title data", Fig. 18 [73, 83]).

**Regarding dependent claims 6 and 23**, Maegawa further discloses comprising: automatically distributing meta material to a second computer over a system of networked computers (Figs. 17, 18).

**Regarding dependent claims 7 and 24**, Maegawa further discloses comprising: automatically authoring marketing material relating to said title material (Fig. 18, Col. 19 line 42 "advertisement").

**Regarding dependent claims 8 and 25**, Maegawa further discloses: automatically distributing said marketing material to a second computer over a system of networked computers (Fig. 17, Col. 18 lines 7-18).

**Regarding dependent claims 9 and 26**, Maegawa further disclosing automatically authoring control material (Fig. 2 [328, 330]) relating to said title material (Col. 9 lines 38-46).

**Regarding dependent claim 10**, Maegawa further discloses comprising: automatically distributing said control material (Col. 9 lines 41-46).

**Regarding dependent claim 14**, Maegawa further comprising automatically authoring a plurality of title materials (Fig. 2, [342, 345]) derived from said at least one database file using said automation program, macro, or module (Fig. 2).

**Regarding dependent claim 15**, Maegawa discloses wherein said step of automatically authoring occurs in response to a request to obtain said title material by a recipient (Fig. 15, Col. 17 lines 40-45).

**Regarding dependent claim 18**, Maegawa discloses wherein said title material is sold (Col. 9 lines 38-50) via said second computer over said system of networked computers to an end-user (Fig. 17).

**Regarding dependent claim 19**, Maegawa discloses wherein said system of networked computers is the Internet (Fig. 17 [800], Col. 18 lines 7-9).

**Regarding dependent claims 27, 29, and 30**, Maegawa further disclosing meta material (Col. 19 line 41 "content data", Fig. 18 [72, 82]) relating to said title material (Col. 19 line 42 "title data", Fig. 18 [73, 83]) wherein said meta material is automatically authored by said computer ( Fig. 18 [73, 83]) and automatically distributed to a second computer by said computer over system of networked computers (Fig. 17); marketing material (Col. 19 lines 40-42 "advertisement") relating to said title material, wherein said marketing material is automatically authored by said computer (Figs. 18 and 20, [73, 83] Col. 19 lines 47-50) and automatically distributed to said second computer by said computer over said system of networked computers (Fig. 17, Col. 18 lines 4-19); control material relating to said title material (Col. 19 line 43), wherein said control material is automatically authored by said computer (Figs. 18 and 20 [73, 83], Col. 19 lines 47-50); and a recipient, wherein said recipient purchases said title material via said second computer over said system or networked computers (Fig. 17).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3, 20, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maegawa, U.S. Patent No. 5,966,386 - filed (03/4/97) in view of Yamane et al., U.S. Patent No. 6,393,196 B1, filed (9/26/97).**

**Regarding dependent claims 3, 20, and 31,** Maegawa as applied to claims 1, 16, and 27 above disclose every aspect of applicant's claimed invention except for authoring title material in more than one language.

Fig. 2 of Yamane et al. disclose an authoring system having title material in more than one language (Col. 13 lines 22 – 23).

Maegawa and Yamane et al. are analogous because both relating to authoring system for title of data, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the title authoring system of Maegawa with multiple languages title authoring system of Yamane et al. for the purpose of providing to the user the selection of languages of interests (Yamane, Col. 13 lines 32 – 33).

**Claims 4 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maegawa, U.S. Patent No. 5,966,386 - filed (03/4/97) in view of Foreman et al., U.S. Patent No. 6,628,303 B1, filed (7/29/96).**

**Regarding dependent claims 4 and 21,** Maegawa as applied to claims 1, and 16, above disclose every aspect of applicant's claimed invention except for saving the title material in at least two formats.

Fig. 14 of Foreman disclosing an authoring system for video in a computer system having saving [260] title material [250] in at least two formats (Col. 16, lines 57 – 64).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the saving the title material in multiple formats taught by Foreman to the title material of Maegawa for the purpose of providing flexibility format in multimedia systems ( Foreman, Col. 16 lines 58 - 59).

**Claims 11 - 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maegawa, U.S. Patent No. 5,966,386 - filed (03/4/97) in view of Saigh et al., U.S. Patent No. 6,633,877 B1, filed (9/26/2000).**

**Regarding dependent claims 11 - 13,** Maegawa as applied to claims 1, 11, and 12, above disclose every aspect of applicant's claimed invention except for wherein said title material comprises a work that is capable of being associated with a unique identification alpha-numeric code; and wherein said code comprises an ISBN code, an ISSN code, a UPC number, or an SKU code, and wherein said title material comprises a written publication.

Fig. 2 of Saigh et al. disclose published distribution system having title material comprises a work that is capable of being associated with a unique identification alpha-numeric code; and wherein said code comprises an ISBN code, an ISSN code, a UPC number, or an SKU code, and wherein said title material comprises a written publication (Col. 6 lines 26 – 28).

Maegawa and Saigh et al. are analogous because both related to authoring published distribution system, It would have been obvious to one have ordinary skill in the art at the time the invention was made to apply the title written publication by ISBN code taught by Saigh et al. to the title written publication of Maegawa for the purpose of providing alpha-numeric international communication network which is provided by ISBN (Saigh, Col. 6 lines 26 – 28).

**Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maegawa, U.S. Patent No. 5,966,386 - filed (03/4/97) in view of Brodersen et al., U.S. Patent No. 6,453,459 B1, filed (1/21/1998).**

**Regarding dependent claim 28,** Maegawa as applied to claim 16, above discloses every aspect of applicant's claimed invention except for a template, wherein said template is used to author a plurality of title materials using said automation program, macro, or module, wherein said plurality of title materials are to be commercially available.

Fig. 1 of Brodersen et al. disclose a authoring movie titles (Col. 5 lines 13 – 14) for distribution through network I/O 145 (Col. 5 lines 45 – 52) having for a template (Fig. 3), wherein said template is used to author a plurality of title materials (Col. 7 lines 23 – 37)



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using said automation program, macro, or module (Fig. 1[160]), wherein said plurality of title materials are to be commercially available (Col. 5 lines 49 – 52).

Maegawa and Brodersen are analogous because both related to authoring system for distribution network. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the template of authoring system taught by Brodersen et al. to the authoring system of Maegawa for the purpose of providing authoring system having integrated interface for storing, recalling authoring information, simulator for viewing progressive, and comparative authored movie titles prior to compiling, and for viewing authored movie titles after compiling (Brodersen, Col. 3 lines 40-49).

### ***Prior art***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Herzberg et al.	Patent No. US 5,745,678	Date of Patent: Apr. 28, 1998
Shimizu et al.	Patent No. US 6,374,271	Date of Patent: Apr. 16, 2002
Kobayashi et al.	Patent No. US 6,473,096 B1	Date of Patent: Oct. 29, 2002
Umeda et al.	Patent No. US 5,453,570	Date of Patent: Sep. 26, 1995

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**Contact Information**

7. Any inquiry concerning this communication from the examiner should be directed to Dang Nguyen, who can be reached by telephone at (703) 305-1673. Normal contact times are M-F, 8-4:30.

Upon an unsuccessful attempt to contact the examiner, the examiner's acting supervisor, Stephen Hong, may be reached at (703) 308-5465.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Or faxed to:

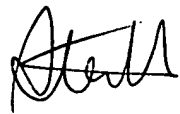
(703) 746-7239 (for formal communications intended for entry)

or:

(703) 746-7238 (for after-final communications)

Hand-delivered responses should be brought to

Crystal Park II, 2121 Crystal Drive  
Arlington, VA, Fourth Floor (receptionist).



**STEPHEN S. HONG**  
**PRIMARY EXAMINER**

Dang Nguyen 2/27/2004